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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,224	03/14/2006	Greg Harris	201144.00002	8390
21324 7590 02/01/2008 HAHN LOESER & PARKS, LLP One GOJO Plaza Suite 300 AKRON, OH 44311-1076			EXAMINER LAMB, BRENDA A	
			ART UNIT 1792	PAPER NUMBER
			NOTIFICATION DATE 02/01/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.		Applicant(s)	
	10/532,224		HARRIS ET AL.	
	Examiner		Art Unit	
	Brenda A. Lamb		1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 8 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Long 4,609,577.

Long teaches the design of an apparatus which is comprised of a component is made from a stainless steel containing an appreciable amount of nitrogen distributed substantially uniformly throughout its microstructure (see column 8 lines 26-31 and

column 4 lines 33-41). The recitation that the component is aluminum corrosion resistant does not define applicant's invention over Long since the claimed composition of the Long component is identical to applicant's claimed composition of the component and therefore the Long component must necessarily exhibit the same properties as those of applicant (see MPEP 2112.01). Further, the Long component or roller is capable of being used in a hot dip coating apparatus and has a surface is capable of coming in contact with the molten metal bath or liquid since it teaches every element of the claimed apparatus which is component made from a resistant stainless steel containing an appreciable amount of nitrogen distributed substantially uniformly throughout its microstructure. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus every element of the claimed apparatus as set forth in claims 1,4,8 and 14 is taught by Long. With respect to claim 2, 5 and 15, Long teaches the weight percent of nitrogen is within the scope of the claims. With respect to claim 3, Long teaches the component is a roller. The Long roller is capable of being used as a sink roller under which the metal strip is passed. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d

1647 (1987). "[A]pparatus claims cover what a device is, not what a device does."

Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Claims 6-7 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long 4,609,577.

Long is applied for the reasons noted above but fails to teach the component includes a further layer which is formed from a stainless steel. However, Long teaches at column 8 lines 26-31 that the core section of the roller is cast from the austenitic stainless steel material within the scope of the claim. Long teaches the layer over the core section is comprised of an austenitic stainless steel material within the scope of the claim. Long fails to teach the roller includes another layer having a surface in contact with the molten metal. However, it would have been prima facie obvious to modify the Long roller by providing an additional layer of the recited stainless steel layer over the recited materials for the obvious advantage of increasing the wear resistance of the roller.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ookouchi et al 5,571,327 in view of Long 4,609,577.

Long is applied for the reasons noted above. Long teaches his austenitic stainless steel roller is used in high temperatures. Long teaches at column 8 lines 26-31 that austenitic stainless steel may be cast to form the roller with the desired configuration and it is known that in casting the components of the metal are in a molten state with components dispersed therein. Long fails to teach his roller or component is

used in a hot dip coating apparatus. However, Ookouchi et al teaches a method of manufacturing a sink roller for a hot dip coating process wherein the sink roller is constructed by casting using an austenitic stainless steel material. Therefore, it would have been obvious to modify the Ookouchi et al process for manufacturing a sink roller by casting using another known austenitic stainless steel material such as taught by Long for the taught advantage of his austenitic stainless steel material – increased service life in high temperature environments and especially in view of Ookouchi et al teaching at column 16 lines 48-52 that its material for use in a molten metal environment may be used in other high temperature environments. Thus claim 9 is obvious over the above cited references. With respect to claims 10-11, Ookouchi et al teaches a method of coating a metal strip in a bath of alloy containing aluminum using a sink roller which is cast from an austenitic stainless steel material. Ookouchi et al fails to teach casting the sink roller from an austenitic stainless steel material within the scope of claim. Therefore, it would have been obvious to modify the Ookouchi et al process by casting the sink roller using another known austenitic stainless steel material such as taught by Long for the taught advantage of his austenitic stainless steel material – increased service life in high temperature environments and especially in view of Ookouchi et al teaching at column 16 lines 48-52 that its material for use in a molten metal environment may be used in other high temperature environment. With respect to claim 11, Ookouchi et al shows in his figures that the metal strip is passed under the sink roller. With respect to claims 12-13, the same rejection applied to claims 6-7 and 16-17 is applied here. Therefore, it would have been prima facie obvious to modify

Ookouchi et al process by using constructing the sink roller using three layers of the Long austenitic stainless steel material for the obvious advantage of increasing the wear resistance of the roller.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the recitation in claims 1,4,8-10 and 14 that the stainless steel is aluminum corrosion resistant further limits the stainless steel composition which is a stainless steel containing an appreciable amount of nitrogen distributed substantially throughout its microstructure and further unclear the degree of aluminum corrosion resistance.

Applicant's arguments filed 10/29/07 have been fully considered but they are not persuasive.

Applicant's argument that Long does not necessarily disclose the nitrogen containing stainless steel of Applicant's invention is found to be non-persuasive since the claimed composition of the Long component is identical to applicant's claimed composition of the component, which is a stainless steel containing an appreciable amount of nitrogen distributed substantially uniformly throughout its microstructure, and therefore the Long component must necessarily exhibit the same properties, including that of being aluminum corrosion resistant, as those of applicant (see MPEP 2112.01).

Applicant's argument that because Long does not disclose his component is immersed in a molten metal bath then it does not disclose applicant's inventive

composition is found to be non-persuasive. The Long component or roller is capable of being used in a hot dip coating apparatus and has a surface is capable of coming in contact with the molten metal bath or liquid since it teaches every element of the claimed apparatus which is component made from a resistant stainless steel containing an appreciable amount of nitrogen distributed substantially uniformly throughout its microstructure. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday- with alternate Wednesdays and Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571)272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda A Lamb
Examiner
Art Unit 1734